

REMARKS

Claims 1-42 are pending in this application.

Applicant respectfully submits that the above amendments and new claims are supported by the original disclosure.

Claim 1 has been amended to delete reference to a "second" searchable database. Claims 1, 10, 12, 19, 21, 28, 29, 31, 32, 34, and 35 have been amended to change the term "database" to --list--. These amendments are supported throughout the original disclosure, including, for example, at page 7, lines 2-8. Applicant respectfully submits that these amendments have been presented to clarify an apparent source of confusion of the Examiner. In the Advisory Action, the Examiner apparently took the position that the first and second databases must be "different" from one another. Such a limitation was not intended.

Claims 2, 3, 11, 12, 20, 21, 29, 32, and 35 have been amended to address matters relating to antecedent basis.

The subject matter of new claims 37 to 42 is supported in the original disclosure at, for example, page 12, lines 6-8 and 20-21, and page 13, lines 15-17.

Accordingly, Applicant respectfully requests approval and entry of the above amendments and new claims.

Claim Rejections -- 35 U.S.C. § 103

Claims 1-6, 10-15, 19-24, and 28-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,751,286 to Barber et al. (hereinafter "Barber") in view of U.S. Patent No. 6,014,581 to Whayne et al. (hereinafter "Whayne").

This rejection is respectfully traversed.

Applicant respectfully submits that Barber and Whayne, when taken alone or in combination with one another, fail to disclose or reasonably suggest the combination of features set forth in the independent claims of the subject application.

The invention as defined in claim 1 is directed to a computer software-mediated method comprising, among other things, the steps of

- (1) providing an electronic list of annotations; and
- (2) associating an annotation from the electronic list with a displayed electronic image, such that the position of the annotation identifies an associated image aspect of the image, and such that the annotation with associated image is searchable.

Applicant respectfully submits that neither Barber nor Whayne discloses a method which involves selecting an annotation an electronic list of annotations and storing an association between the selected annotation and the electronic image for searching.

Barber discloses building a search query from a database of image characteristics (selectable from keywords, text, or alpha-numeric data associated with an image). These image characteristics, presented as “thumbnails,” may be dragged into an image query construction window 23, such as image window 90, for constructing a search query used to access images in a database based on image content. The search query is then used to search the database, wherein the search is based on pixel information from the stored images. If the pixel information of the image matches the content and placement of the image characteristics constructed on image query window 23, then the image is returned to the user.

Applicant respectfully submits that, contrary to the Examiner's assertion, Barber does not disclosing using thumbnails (i.e., alleged annotations of an existing database) for annotating an image. Rather, the thumbnails of Barber are used for constructing a query for the purpose of searching pixel information of images. The thumbnails represent image characteristics to be searched. For example, if the term "bear" is placed in the image query construction window 23, the executed search will locate images with pixel information characteristic of a "bear." (See column 9, line 49 to column 10, line 2) Once the query is run and the relevant images are found, Barber does not disclose displaying the thumbnail positioned in the electronic image so as to permit a user to identify the associated image aspect in the displayed image.

Applicant further respectfully submits that, contrary to the Examiner's assertion, Barber does not disclose storing an association between the thumbnails and the image for later searching. The thumbnails of Barber are used exclusively for searching. Barber makes no mention of establishing or storing associations between the thumbnails and the annotations, or performing later searching of the associations.

In the Advisory Action, the Examiner points to column 8, line 59 to column 9, line 61 of Barber as allegedly disclosing the missing claimed features. Applicant respectfully disagrees. This passage of Barber states that the selection containers 91-94 contain "thumbnails" (col. 9, lines 19-21), and that the thumbnails are dragged to image window 90 to construct a "search image" (col. 9, lines 33-35). As explained above, the search query is used to search the database based on pixel information from the stored images; the search query does not become an annotation associated with the image.

To the extent that Barber mentions textual tags, column 9, lines 17-19 state that the “arbitrary textual tag ... can be appended to an image or an image mask.” Thus, in Barber the “arbitrary” textual annotation is neither obtained from an electronic list of annotation (i.e., the thumbnails are search parameters, not textual annotations assigned to the images) nor displayed positioned in the electronic image so as to permit a user to identify the associated image aspect in the displayed image.

The Examiner points to Whayne as allegedly disclosing an annotation that is positioned to identify an associated image aspect of an image. (See column 24, lines 38-58 and Fig. 19 of Whayne). Whayne states that the “operator enters the desired comment into the comment window 406 using the keyboard 40.” Like Barber (which mentions “arbitrary textual tags”), Whayne does not disclose a list of annotations from which an annotation may be selected and associated with an image. Therefore, Whayne fails to overcome the deficiencies of Barber.

For these reasons, Applicant respectfully submits that the Section 103(a) rejection of claim 1 should be reconsidered and withdrawn.

Independent claims 10, 19, 28, 31, and 34 recite methods and electronic images, and collections of electronic images involving an electronic list of annotations, wherein the annotations of the electronic list are capable of being associated with image aspects of images for later retrieval. As explained in detail above, neither Barber nor Whayne discloses these claimed features.

With regard to the remaining claims, Applicant respectfully submits that each is dependent upon a corresponding independent claim and includes all of the distinguishing features thereof. Additionally, claims 3, 12, 21, 29, 32, and 35 recite elements or steps of

selecting, dragging, and dropping an annotation from an electronic list to a user-selected location in the displayed electronic image. The Examiner acknowledged that neither Barber nor Whayne disclose this feature, but has taken Official Notice “that it is well known in the art for annotations to be created/edited and stored/saved in a searchable database which could be later displayed in a list for selection by a user.”

Applicant respectfully traverses this use of Official Notice. MPEP § 2144.03 proscribes the use of Official Notice to establish the state of the art:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also ...In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art....”)

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See MPEP § 2144.03. Further, the Examiner has not pointed to any evidence of record to support the assertion of common knowledge. The Examiner has not provided specific factual findings predicated on sound technical and scientific reasoning to support his conclusion that the claimed feature is well known or of common knowledge. See *In Re Soli*, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963).

Pursuant to MPEP § 2144.04, in view of this traversal of the Examiner’s use of Official Notice, “the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko* 258

F.3d at 1386, 59 USPQ2d at 1697 ('[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings' to satisfy the substantial evidence test)."

In the Advisory Action, the Examiner asserted that Barber as allegedly discloses "the use of different storage locations/areas for different data entries." However, none of these alleged storage techniques of Barber involve the storage of annotations. The entry of annotations in an electronic list, as taught by the present patent application, dramatically simplifies annotation-based searching. *See* specification, page 7, lines 2-8.

For these reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 103 rejection of claims 1-6, 10-15, 19-24, and 28-36.

Claims 7-9, 16-18, and 25-27 have been rejected under Section 103 as being unpatentable over Barber and Whayne, in view of Kuchinsky et al., FotoFile (hereinafter "Kuchinsky").

Applicant respectfully traverses this rejection.

Claims 7-9 depend from claim 1. Claims 16-18 and 25-27 depend from claims 10 and 19, respectively. Applicant has established above that Barber and Whayne, when taken alone or in combination, fail to render claims 1, 10, and 19 unpatentable. Kuchinsky, which has been cited for their alleged disclosure of photograph labeling, does not overcome the deficiencies of Barber and Whayne. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

In view of the foregoing, Applicant respectfully submits that the pending claims are allowable and that the application is in condition for allowance. Reconsideration of the application in view of this response and its passage to issue are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule same.

Respectfully submitted,



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